

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:) Confirmation No. 1445
Bo SERWIN) Group Art Unit: 1794
Application No. 10/553,444) Examiner: Sheeba Ahmed
Filed: July 31, 2006)
For: SANDWICH PLATE-LIKE)
CONSTRUCTION)

ELECTION

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the restriction requirement contained in the Office Action that was issued on January 26, 2009, applicant traverses the requirement on the following basis.

Restriction has been required under 37 CFR 1.499 which must be based on a finding of a lack of unity under 37 CFR 1,475. 37 CFR 1,475 states in relevant part:

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (“requirement of unity of invention”). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a **national stage application** containing claims to different categories of invention **will be considered to have unity of invention** if the claims are **drawn only to** one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product;

Here, claim 1 is directed to a product and claim 14 is directed to a process specially adapted for the manufacture of that product, the claim 1 product being recited *verbatim* in claim 14. Thus, under 37 CFR 1.475(b)(1), the groups of claims should be found to have unity of invention.

Further more the Examiner refers to PCT Rule 13.1 and Rule 13.2 and indicated that the required corresponding technical features are lacking. The cited PCT rules correspond to the above quoted 37 CFR 1.475(a) in which it is set for that the “expression ‘special technical features’ shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art”

The Examiner has indicated that the lack of “special technical features” is evidenced by the purported failure “to make a contribution beyond that of the prior art as evidenced by the references marked ‘X’ and ‘Y’ in the PCT search report. However, it is noted that only Y and A category documents are mentioned in the International Search Report and as correctly stated in the written opinion prepared by the International Search Authority, the claims, and thereby the invention, is novel, such that a contribution beyond that of the prior art exists.

According to normal PCT practice and practice at the European Patent Office, the special technical features are those features which are not disclosed in one single prior art document. For this analysis, the examiner is free to choose any available prior art document and isolate the features which are not comprised in this particular prior art document. This feature is henceforth referred to as the special technical feature.

According to the PCT procedure, the International Authority did not raise an objection relating to non-unity in that when an invention defined in the main claim differs from the prior art by corresponding technical features there is novelty and unity even though there may not be an inventive step.

It is therefore submitted that the examiner’s objection to non-unity with reference to the PCT Convention is incorrect and is in contravention to the above quoted U.S. rules so that the restriction requirement should therefore be withdrawn.

Nonetheless, as required, applicant provisionally elects Group I, i.e., claims 1-13 for examination on the merits in the event that the restriction requirement is not be withdrawn.

Respectfully submitted,



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